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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,726	12/05/2003	Thomas C. Burke	NEX-101-US	1726

45464 7590 09/21/2006

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,726

Applicant(s)

BURKE ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10 and 12-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed June 6, 2006.
Claims 1-3, 5, 7 and 10 have been amended and claims 6 and 11 were cancelled rendering claims 1-5, 7-10 and 12-13 pending.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5, 7-10 and 12-13 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1-3 and 7, the phrase, 'oleic palmitamide' is not supported by the specification. There is support for oleyl palmitamide.

Claim Rejections – 35 USC 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1774

5. Claims 1-5 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase, "one or a blend of polymeric resins having opposed first and second outer surfaces" is indefinite. It is unclear the first and second outer surfaces is referring to the film or to the polymeric resin.

In claim 2, the phrase, "one or a blend of non-polyolefin resins...having opposed first and second surfaces" is indefinite. It is unclear the first and second outer surfaces is referring to the film or to the polymeric resin.

In claim 3, the phrase, "one or a blend of polyolefins... having opposed first and second surfaces" is indefinite. It is unclear the first and second outer surfaces is referring to the film or to the polymeric resin.

Objection

6. In claim 13, the term "Nylon" is objected to as being a trade name well known in the art, and should be lower case and spelled "nylon". Appropriate correction is requested.

Claim Rejections – 35 USC § 102(b)

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 4-5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Creekmore et al (U.S. 4,112,158).

Creekmore discloses a thin multilayer polymer film between about 0.5 to about 20mils thick comprising 0.1 to about 3 parts of stearyl erucamide and oleic palmitamide (abstract, column 1, lines 28-45, lines 66, column 2, lines 1-5 and column 5, lines 18-20) where the film of Creekmore further comprises polyethylene (column 3, lines 47-48). It is inherent for the film of Chang to have the structures as in claims 4 and 9 since the primary amide is erucamide and the secondary amide is stearamide. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

Claim Rejections – 35 USC § 103(a)

9. Claims 2-3 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Creekmore et al (U.S. 4,112,158).

Creekmore is relied on for claims 1 and 7. Creekmore does not explicitly disclose

Art Unit: 1774

that the primary and secondary amides have a ppm as in instant claims 4 and 9.

However, such features are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ppm, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ppm) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it directly affects the strength of the film. It would have been obvious to one of ordinary skill in the art to make the film with the limitations of the primary and secondary amide ppm since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). Although Creekmore discloses a polyethylene material, the reference does not specify if the material is high or low density. It is the Examiner's interpretation that polyethylene is expected to either be low density or high density, which renders the polyethylene disclosed by Creekmore to meet the claim limitation of instant claim 3. In instant claim 12, the phrase, "may be printed in a decorative manner" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claim 13, the phrase, "joined to a secondary film by adhesives, extruded polymer or by thermal bonding" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

Art Unit: 1774

unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Response to Arguments

10. Rejection made under 35 U.S.C. 112, second paragraph is withdrawn due to Applicant amending claim 1 to include a migratory additive as suggested.

The objection made over claims 10 and 11 is withdrawn due to Applicant's amendment canceling claim 11.

Rejection made under 35 U.S.C. 102(b) as being anticipated by Stolk (U.S. 6,063,445) is withdrawn due to Applicant amending claim 1 to include “a migratory additive comprising a blend of secondary amides about 1 part oleic palmitamide and 1 part stearyl erucamide.”

Rejection made under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) as being anticipated by Chang et al (U.S. 6,503,611) is withdrawn due to Applicant amending claim 1 to include “a migratory additive comprising a blend of secondary amides about 1 part oleic palmitamide and 1 part stearyl erucamide.”

Rejection made under 35 U.S.C. 103(a) as being unpatentable over Chang et al (U.S. 6,902,822) in view of Creekmore et al (U.S. 4,112,158) is withdrawn due to Applicant amending claim 1 to include “a migratory additive comprising a blend of secondary amides about 1 part oleic palmitamide and 1 part stearyl erucamide.”

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 9/15/04